REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-9, 15-23, 29-37, 43-53 are pending, Claims 45-53 having been presently amended.

In the outstanding Office Action, Claims 1-9, 15-23, 29-37 and 43 were rejected under 35 U.S.C. § 103(a) as being anticipated by Biorge et al (U.S. Pat. No. 5,806,045) in view of Stein et al (U.S. Pat. No. 5,459,306) and Hertz et al (U.S. Pat. No. 5,754,938). Claim 44 was rejected under 35 U.S.C. § 103(a) as being obvious over Stewart (U.S. Pat. No. 6,452,498) in view of Stein et al and Hertz et al. Claims 45-53 were rejected under 35 U.S.C. § 103(a) as being obvious over Biorge et al in view of Stewart and Hertz et al and further in view of Merriman et al (U.S. Pat. No. 5,949,061).

Firstly, Applicants acknowledge with appreciation the courtesy of Examiner Champagne to review this case and clarify that the present Office Action relies on Hertz et al and not Stein et al for a teaching of without providing to an advertiser the purchase history of the consumer.

Secondly, Applicants acknowledge with appreciation the courtesy of Examiner Champagne to recommend that any differences between the present invention and the applied prior art references be submitted as an after final response, given the apparent agreement during the interview of May 11, 2004 that has now been reversed by the final Office Action.

Independent Claims 1, 3, 15, 17, 29, and 31 define that a targeted advertisement is selected and electronically delivered to a consumer, based on a purchase behavior classification without providing to an advertiser the purchase history of the consumer. In response to the previously filed arguments, the outstanding Office Action acknowledges that Hertz et al teach means by which the consumer identity is released with their consent, but

states that this factor is irrelevant, as the consumer can do anything they want with their own private information and because at least some consumers in Hertz et al want data related to their purchase history (purchasing patterns at line 38 and purchasing behavior at line 41) to be kept confidential.[1] On this basis, the Office Action asserts that it would be obvious to one of ordinary skill in the art, at the time of the invention, to make the selecting without providing to an advertiser the purchase history of the consumer. Yet, regardless of whether consumers can do anything they want, the teachings in Hertz et al disclose two mechanisms (1) release with true identity in exchange for cash or other consideration[2] and (2) encrypted release without a true identity when purchase history information is to be kept confidential.[3] In the first mechanism, there would seem to be no dispute that Hertz et al teach away from the claimed invention in that the advertiser is provided with a consumer's purchase history by the consumer's consent. In the second mechanism, the advertiser is still provided with a consumer's purchase history, although the advertiser does not know the entity of the consumer due to the encryption techniques. Thus, in both cases a purchase history of a consumer (identified or anonymous) is provided to the advertiser. Hence, in either case, Hertz et al teach away from the claimed invention of selecting and electronically delivering the targeted advertisement without providing to an advertiser the purchase history of the consumer.

Thirdly, in response to the previously filed arguments, the outstanding Office Action misconstrues the point of Applicants' previous argument with respect to Stein et al. The outstanding Office Action acknowledges that the host system 13 in Stein et al informs the

[1] Office Action, page 4, lines 26-32.
[2] Hertz et al, column 5, lines 55-59.
[3] Id., column 5, lines 53-55.

POS computer 11 of promotions (ads), which can be interpreted as sending ads to the POS computer 11.[4] Indeed, Stein et al disclose that:

> The host system 13 communicates with the point-of-sale computer 11 on an infrequent, but regular, basis. It is advantageous for ***the host system 13*** to dial up the point-of-sale computer 11 once per day and ***poll*** the point-of-sale computer 11 ***for*** current information on inventory and ***new information collected on customers***.
>
> At the same time, ***the host system 13*** preferably ***informs*** the point-of-sale computer 11 of updates and changes to code and data, ***promotions,*** graphics, rules, products, and customers.

The claims define selecting and electronically delivering the targeted advertisement to the consumer at the first computer in response to receiving the first identifier from the first computer, said selecting based on said purchase behavior classification without providing to an advertiser said purchase history. Hence, the host computer in Stein et al is an advertiser (i.e., the source of promotions). Further, in Stein et al, new information collected on the customers is provided to the host computer (i.e., provided to the advertiser) by the host computer's periodic polling. Thus, Stein et al also teach away from the claimed invention by selecting and electronically delivering the targeted advertisement (i.e., by updating and changing code to the promotions) after obtaining consumer purchase history (i.e., after polling for new information collected on customers).

Hence, it is respectfully submitted that both Stein and Hertz et al, when considered as a whole, teach away from the present invention, and thus provide no motivation for one of ordinary skill in the art to make the combination asserted in the outstanding Office Action.

Regarding Claim 44, Claim 44 was rejected under 35 U.S.C. § 103(a) as obvious over Stewart in view of Stein et al and Hertz et al. Applicants respectfully traverse this rejection for the same reasons as given above, i.e., that both Stein et al and Hertz et al teach away from the claimed invention.

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[4] Office Action, page 5, lines 3-13.

Finally, Claims 45-53 including independent Claim 53 presently define that the cookie number is associated at a second computer with the purchase behavior classification in order to deliver the targeted advertisement to the consumer without providing to the advertiser the consumer's purchase history.[5] Such features are not disclosed or taught in Merriman et al.

Given the above arguments, Applicants respectfully submit that independent Claims 1, 3, 15, 17, 29, 31, and 53 and the claims dependent therefrom, patentably define over the applied prior art.

Consequently, in view of the present amendment and in light of the above discussions, the application is believed to be in a condition for allowance. Therefore, an early and favorable action is respectfully requested.

Respectfully submitted,

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[5] See Figure 4(a) of the specification and the discussion in the specification thereof for support.